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EXAMINER

MAGUIRE, LINDSAY M

ART UNIT

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3692

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/811,011

**Applicant(s)**

MICCI-BARRECA, DANIELE

**Examiner**

LINDSAY M. MAGUIRE

**Art Unit**

3692

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28, 33-60 and 97-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28, 33-60 and 97-116 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date \_\_\_\_\_
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Non-Final Office Action is in response to the application filed on March 26, 2004, the response to the Election/Restriction requirement filed on February 26, 2008, and the Request for Continued Examination filed on December 8, 2008.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 8, 2008 has been entered.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 13, 15, 23, 24, 33, 97, 101, and 112 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically the

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phrase, "automatically modifying the weight of at least one of the plurality of rules based on the result" in lines 12-13 of claim (similarly recited in claims 13, 15, 23, 24, 33, 97, 101, and 112) is not present in the specification. While the specification does provide support for adjusting the weight of one of a plurality of rules, it does not provide support for automatically modifying them.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1-28 and 97-116 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines. '); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').<sup>7</sup> A claimed process involving a fundamental

principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

Claims 1-28 and 97-116 are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing; therefore, claims 1-28 and 97-116 are non-statutory under § 101.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-28, 33-60, and 97-116 are rejected, inasmuch as the claims are best understood given the 35 USC 101 and 112 first paragraph rejections (as advanced above), under 35 U.S.C. 103(a) as being unpatentable over U.S. PGPub. No. 2002/0099649 (Lee et al. '649) in view of U.S. PGPub. No. 2002/0161711 (Sartor et al. '711), and in further view of U.S. Pat. No. 6,714,918 (Hillmer et al. '918).

With respect to claims 1-8 and 33-40, Lee et al. '649 disclose a method/system performed by an information handling system ("IHS"), the method comprising: receiving a first financial transaction request (abstract); applying a plurality of rules to the first financial transaction request to determine a first score, each (Figure 1); determining a first indication of whether the first financial transaction request is likely fraudulent based on the first score (paragraphs [0043, 0045, 0066, 0115]). Additionally Lee et al. '649 disclose adjusting the weight of at least one of the plurality of rules in response to a command from a user (paragraphs [0075, 0210 - 0214]); receiving a second financial transaction request (104, 110; Figures 1 & 2), and applying the plurality of rules to the second financial transaction request to determine a second score (paragraphs [0045, 0066, 0115], i.e. in order to learn the pattern of transactions, first transactions must be made to have something to compare the second transactions to); wherein the IHS is a first IHS, and comprising: receiving the first financial transaction request from a second HIS (104, 110; see Figures 1 & 2); wherein receiving the first financial transaction request comprises: receiving the first financial transaction request from the second IHS through a global computer network (paragraph [0139]); and to the second IHS through the global computer network, outputting an indication of whether the first financial transaction request is likely fraudulent (paragraphs [0342 – 0348]). Lee et al. '649 further disclose that the financial transaction request includes determining the first indication includes comparing the first score to a threshold (paragraph [0043, 0045, Figures 1 and 2]).

Lee et al. '649 disclose the method substantially as claimed, as advanced above with the exception of explicitly requiring accessing an actual outcome of the first financial transaction request to determine a result indicating whether the first indication was correct based on the actual income and automatically modifying the weight of at least one of the plurality of rules based on the result. However, Lee et al. '649 does disclose a transaction detection rate that represents the number of correctly identified fraudulent orders and a transaction false-positive rate that represents the number of orders incorrectly identified as fraudulent orders. Lee et al. '649 further disclose using these rates to determine the score thresholds (paragraphs [0364-0370]). Sartor et al. '711 disclose that the values of the variables can be set according to the actual history of fraud (paragraph [0003]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lee et al. '649, in view of the teachings of Sartor et al. '711, to access an actual outcome of the first financial transaction after determining a result indication whether the first indication was correct for the basic reason of reducing the false-positive rate.

Regarding claims 13-23, 25, 27, 28, 45-55, 57, 59, and 60, Lee et al. '649 disclose a method/system performed by an information handling system ("IHS") comprising: determining whether a first financial transaction request is actually fraudulent; and in response to determining whether the first financial transaction request is actually fraudulent, adjusting respective weights of a plurality of rules for determining whether a second financial transaction request is likely fraudulent (abstract; paragraphs

[0045, 0066, 0075, 0115, 0210-0214]). Additionally, Lee et al. '649 disclose outputting a first indication of whether the first financial transaction request is likely fraudulent based on the first score (paragraphs [0364-0371]); determining a second score for the second financial transaction request by applying the plurality of rules to the second financial transaction (paragraphs [0043, 0045, 0066, 0115]), determining whether the second financial transaction request is actually fraudulent; and in response to determining whether the second financial transaction request is actually fraudulent, adjusting the weight of at least one of the plurality of rules for determining whether a third financial transaction request is likely fraudulent (paragraphs [0045, 0066, 0075, 0115]); wherein the IHS is a first IHS, and comprising: receiving the second financial transaction request from a second HIS (104, 110, Figures 1 and 2); wherein receiving the second financial transaction request comprises: receiving the second financial transaction request from the second IHS through a global computer network (paragraph [0139]); and to the second IHS through the global computer network, outputting an indication of whether the second financial transaction request is likely fraudulent (paragraphs [0342-0348]). Lee et al. '649 further disclose that the first financial transaction request is actually non-fraudulent (paragraphs [0036, 0037, 0043]; i.e. the transactions that are used to develop the history of purchases); wherein the first financial transaction request is actually fraudulent (paragraphs [0036, 0037, 0043]; i.e. the first transaction made to a particular merchant that doesn't fit the users profile); wherein the first financial transaction request includes information about a financial account that is associated with the first financial transaction request (paragraph [0043]); adjusting the weight of at least one of the

plurality of rules in response to a command from a user (paragraphs [0075, 0210-0214]); wherein adjusting the weights comprises: adjusting the weight of at least one of the plurality of rules to improve a predictive accuracy of the weights (paragraphs [0075, 0210-0214]); and in response to determining whether the first financial transaction request is actually fraudulent, adjusting a threshold and applying the threshold to the second score for determining whether the second financial transaction request is likely fraudulent (paragraphs [0064-0067]).

Additionally, Lee et al. '649 disclose that in response to determining whether the first financial transaction request is actually fraudulent, storing an actual result for the first financial transaction request and the first financial request to a valid/invalid transaction database (314).

Lee et al. '649 disclose the method substantially as claimed, as advanced above with the exception of explicitly requiring automatically modifying the weight of at least one of the plurality of rules based on the result. However, Lee et al. '649 does disclose a transaction detection rate that represents the number of correctly identified fraudulent orders and a transaction false-positive rate that represents the number of orders incorrectly identified as fraudulent orders. Lee et al. '649 further disclose using these rates to determine the score thresholds (paragraphs [0364-0370]). Sartor et al. '711 disclose that the values of the variables can be set according to the actual history of fraud (paragraph [0003]). Therefore, it would have been obvious to one of ordinary skill

in the art at the time the invention was made to modify Lee et al. '649, in view of the teachings of Sartor et al. '711, for the basic reason of reducing the false-positive rate.

Lee et al. '649 discloses the method substantially as claimed, as advanced above, with the exception of requiring: (a) activate a subset of the rules based on the information in the first financial transaction request, each of the plurality of rules having a predetermined weight and determining a first score by calculating a sum of the weights of the activated rules and applying a mathematical formula using the sum (claim 1, lines 2-6; claim 13, lines 5-8; claim 33, lines 5-9; claim 45, 4-8; claim 97, lines 6-10); (b) transmitting the first indication to the provider to accept or deny the first financial transaction (claim 1, lines 10-11); (c) that the plurality of rules include at least one positive rule that, if satisfied, indicates that a financial transaction request has an increased likelihood of being non-fraudulent (claim 9, lines 1-3; claim 11, lines 2-3; claim 41, lines 1-3; claim 43, lines 2-3; claim 58, lines 1-3); (d) that the plurality of rules include at least one negative rule that, if satisfied, indicates that a financial transaction request has a reduced likelihood of being non-fraudulent (claim 10, lines 1-2; claim 11, lines 4-5; claim 42, lines 1-2; claim 43, lines 4-5; claim 58, lines 3-4); and (e) that a value of the at least one positive rule's weight is variable between zero and a number having a first +/- sign; and a value of the at least one negative rule's weight is variable between zero and a number having a second +/- sign opposite of the first +/- sign (claim 12, lines 1-5; claim 44, lines 1-5).

Regarding (a) and (b), Hillmer et al. '918 disclose activating a subset of the rules based on the information in the first financial transaction request, each of the plurality of rules having a predetermined weight and determining a first score by calculating a sum of the weights of the activated rules and applying a mathematical formula using the sum (abstract; column 2, lines 39-60; column 9, lines 22-55), and transmitting the first indication to the provider to accept or deny the first financial transaction (column 12, line 50 – column 13, line 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method/system of Lee et al. '649, in view of the teachings of Hillmer et al. '918, to include a first score by calculating a sum of the weights and applying a mathematical formula using the sum, and transmitting the indication to the provider for the basic reason of combining known elements to yield predictable results.

Regarding (c) - (e), Lee et al. '649 does disclose that there are a plurality of rules, and that the merchants can, "write policies formulated as computational rules that become active within the rules engine.....the merchants define, edit, delete any rule it desires...the rules enables the merchant's fraud-risk prediction system to automatically determine actions based on fraud scores..." (paragraph [0075]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the merchant could make a positive rule that indicates non-fraudulent activities and a negative rule that indicates fraudulent activities for the basic reason creating rules that work best for the user. Additionally, Lee et al. '649 disclose that the rules can be

changed however the user sees fit, which would include editing the rule's weight value of both positive and negative rules to include sign changes for the obvious reason of allowing the user to customize the system to their use.

Regarding claims 97-104 and 111-116, these claims are substantially similar to claims 1-28 and 33-60, and are rejected using the same art and rationale, as advanced above.

With respect to claims 105-110: Lee et al. '649 discloses that financial account information includes at least one of account holder information, account number information, account expiration information, and account billing information (paragraph [0064]); that previous financial transaction request includes transaction information (paragraph [0065]); that the transaction includes at least one of shipping information and transaction type information (paragraph [0064]); that the transaction information includes IP address information and that the IP address information is associated with a customer (paragraph [0064]).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-28, 33-60, and 97-116 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts of disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSAY M. MAGUIRE whose telephone number is (571)272-6039. The examiner can normally be reached on M-F: 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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